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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,725	01/27/2000	Robert G. Arsenault	PD-980142	1296

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/492,725

Applicant(s)

ARSENAULT ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Specification*

#### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are directed to a non-functional and non-descriptive subject matter because the claims recite a **data structure**. However, upon examining the claims, it appears that there is no **pointing or indexing**, related to the data stored in the readable medium, that is usually associated with a **data structure** and that the claims simply refer to advertisement data stored on a computer readable medium or Hard drive in a conventional manner. A **data structure** could be replaced with a computer-implemented method for manipulating...

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17 recite the limitation "the schedule". There is insufficient antecedent basis for this limitation in the claims, especially in claim 1, since this is the first time the term

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**schedule** is used in the claims. For examination purpose, the Examiner assumes that the Applicant meant to refer to --a schedule--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Joyce et al., WO 97/12486.

As per claim 1, Joyce et al. disclose a method and/or system for presenting advertisements to a subscriber or viewer in an interactive manner wherein a video server stores in a programming database primary programming and secondary programming or advertisements scheduled to be displayed, during specific program breaks, on the subscriber's unit based on the subscriber's profile stored in a subscriber database. Furthermore, the primary programming contains images related to the content of the secondary programming or advertisements. It is to be understood that each advertisement has an associated id or identifier or tag inherently used to uniquely identify the stored advertisement in the programming database (See abstract; page 2: 16 to page 4: 29; fig. 1).

As per claims 2-17, Joyce et al. further disclose a method and/or system for presenting advertisements to a subscriber or viewer in an interactive manner wherein a video server stores in a programming database primary programming and secondary programming or advertisements scheduled to be displayed, during specific program breaks, on the subscriber's unit based on the subscriber's profile including preferences and demographics (geographic location) stored in a subscriber database. Furthermore, the primary programming contains images related to the content of the secondary programming or advertisements. It is to be understood that each advertisement has an associated id or identifier or tag inherently used to uniquely identify the stored advertisement in the programming database. The subscriber can also select, using a web browser, a primary program such as a movie by click on an icon or an image representing the movie wherein the said movie will be shown on his TV 502 of fig. 1 (See abstract; page 2: 16 to page 4: 29; fig. 1; page 9: 29-37).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 18-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Hite et al., US Patent 5,774, 170A.

As per claim 18, Hite et al. disclose an enhanced television (radio) advertising method and/or system by targeting, delivering and displaying advertisements within specified programming, during program breaks, in pre-determined households having specific and addressable units while preventing advertisements from being displayed in other households (See abstract). The system comprising appropriate hardware and software wherein an Ad Administration Facility having stored therein advertisements and programs for analysis and classification and the results of this analysis and classification are stored in databases. In addition, advertisements or commercials are received from agencies that created them and processed them as necessary for use in the system. These processed commercials (first group or first source of advertisements) having associated CID codes (commercials ID) constructed from information or results stored in databases associated with the Administration Facility 100 of fig. 1 are conveyed or transmitted to Ad Transmission Facility 200, which combines the processed commercials and CID codes with programming and transmits the result to a plurality of Media Origination Facility 300 for delivery to the display site (reception site) 400 based on the viewer's interest. The Media Origination Facility 300 also receives programming and commercials from other sources (second group of commercials) and creates some programming and commercials in

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its own facilities wherein these commercials and programming are scheduled to be transmitted to the viewer's unit based on his demographic and psychographic profile. Finally, a viewer is targeted with a list of advertisements from the first group or second group based on his profile and the advertisements will be displayed in a correct sequence according to a sequencing code store at the point of viewing (fig. 1; col. 8: 63 to col. 9: 42; col. 3: 65 to col. 4: 2; col. 4: 45-51; col. 8: 29-38).

See col. 3: 16 to col. 8: 43 for more details.

As per claims 19-23, Hite et al. disclose an enhanced television (radio) advertising method and/or system by targeting, delivering and displaying advertisements within specified programming, during program breaks, in pre-determined households having specific and addressable units while preventing advertisements from being displayed in other households (See abstract). The system comprising appropriate hardware and software wherein an Ad Administration Facility having stored therein advertisements and programs for analysis and classification and the results of this analysis and classification are stored in databases. In addition, advertisements or commercials are received from agencies that created them and processed them as necessary for use in the system. These processed commercials (first group or first source of advertisements) having associated CID codes (commercials ID) constructed from information or results stored in databases associated with the Administration Facility 100 of fig. 1 are conveyed or transmitted to Ad Transmission Facility 200, which combines the processed commercials and CID codes with programming and transmits the result to a plurality of Media Origination Facility 300 for delivery to the display site (reception site) 400 based on the viewer's

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interest. The Media Origination Facility 300 also receives programming and commercials from other sources (second group of commercials) and creates some programming and commercials in its own facilities wherein these commercials and programming are scheduled to be transmitted to the viewer's unit based on his demographic and psychographic profile. Finally, a viewer is targeted with a list of advertisements from the first group or second group based on his profile and the advertisements will be displayed in a correct sequence according to a sequencing code store at the point of viewing (fig. 1; col. 8: 63 to col. 9: 42; col. 3: 65 to col. 4: 2; col. 4: 45-51; col. 8: 29-38).

See col. 3: 16 to col. 8: 43 for more details.

As per claim 24, Hite et al. disclose an enhanced television (radio) advertising method and/or system by targeting, delivering and displaying advertisements within specified programming, during program breaks, in pre-determined households having specific and addressable units while preventing advertisements from being displayed in other households (See abstract). A suitable process is used to target prospective viewers of a set of advertisements using database search and list selection procedures. The result of this process is a set of appropriate CID codes for the prospective viewers. These CID codes are transmitted to the viewing device or unit where it is stored and subsequently used to match CID transmitted with advertisements embedded in a programming. When a match is found between the locally stored CID and the CID (commercial ID) transmitted with the advertisement or commercial, the commercial is then presented to the viewer. If there is no match, the commercial is ignored and not displayed (col. 3: 65 to col. 4: 18; col. 8: 29-38).

As per claims 32-34, Hite et al. disclose an enhanced television (radio) advertising method and/or system by targeting, delivering and displaying advertisements within specified programming, during program breaks, in pre-determined households having specific and addressable units while preventing advertisements from being displayed in other households (See abstract). A suitable process is used to target prospective viewers of a set of advertisements using database search and list selection procedures. The result of this process is a set of appropriate CID codes for the prospective viewers. These CID codes are transmitted to the viewing device or unit where it is stored and subsequently used to match CID transmitted with advertisements embedded in a programming. When a match is found between the locally stored CID and the CID (commercial ID) transmitted with the advertisement or commercial, the commercial is then presented to the viewer. If there is no match, the commercial is ignored and not displayed (col. 3: 65 to col. 4: 18; col. 8: 29-38).

As per claim 25-31 and 36-40, Hite et al. disclose an enhanced television (radio) advertising method and/or system by targeting, delivering and displaying advertisements within specified programming, during program breaks, in pre-determined households having specific and addressable units while preventing advertisements from being displayed in other households (See abstract). When a match is found between the locally stored CID and the CID (commercial ID) transmitted with the advertisement or commercial, the commercial is then presented to the viewer. If there is no match, the commercial is ignored and not displayed and a default advertisement in the batch of locally stored advertisements having a low priority is considered

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unless it is replaced with a higher priority commercial (col. 3: 65 to col. 4: 18). Moreover, an unconditional preemptable commercial may be subject to substitution or replacement whenever other higher priority commercials are available (col. 3: 55-57; col. 8: 29-38). Advertisements are transmitted and stored locally in a viewer's unit along with suitable CIDs to be subsequently presented to the viewer. A broadcast with a break to present a targeted commercial may then be transmitted with codes or CIDs in the break point. If there is a match between the stored CIDs and the transmitted CIDs, an appropriate commercial is presented, perhaps more than once. If a certification or registration code is included, that code is returned upstream to the signal origination site when commercials are successfully presented. **The presented or used commercial will then be replaced with another commercial or a new commercial, which is just received and stored in the viewer's unit, thereby updating** the local database or local storage medium associated with the viewer's unit and especially if the newly received advertisement has similar content as the previously viewed advertisement. Further, when there is no match between the stored CID and the received CID associated with the commercial break embedded in the transmitted program, no commercial will be displayed. However, there is always a default advertisement to be displayed. In the case of multiple matches, a prioritization programming will be employed to determine which commercials to be displayed and which ones to ignore. It is to be understood that each advertisement stored in the system to be displayed at the appropriate time has an expiration date and at the end of the expiration date, the advertisement will no longer to be displayed. In the end, the current system has the necessary hardware and software to replace a previously viewed advertisement with a newly transmitted advertisement, to ignore inappropriate advertisement and display a default one having a low

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priority, to select the advertisement having the highest priority in the case of multiple matches (col. 5: 39- col. 8: 38).

As per claim 35, Hite et al. disclose an enhanced television (radio) advertising method and/or system by targeting, delivering and displaying advertisements within specified programming, during program breaks, in pre-determined households having specific and addressable units while preventing advertisements from being displayed in other households (See abstract). When there is no match between the stored CID and the received CID associated with the commercial break embedded in the transmitted program, no commercial will be displayed. However, there is always a default advertisement to be displayed. In the case of multiple matches, a prioritization programming will be employed to determine which commercials to be displayed and which ones to ignore, thereby creating at least one list **or first order** list of advertisements that will be presented on the user's unit or TV in a certain sequence or order according to this prioritization programming (col. 4: 45-51; see claims 10, 16, 54 and 59 of the current reference).

### Conclusion

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

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For information on the status of your case, please call the help desk at (703) 308-1113

. Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325

**Please provide support, that is page and line numbers, for any amended or new claim, otherwise any new claim language that is introduced in an amended or new claim will be considered as new matter.**

JDJ  
06/02/02

*Steve Gravini for GWS*

STEPHEN GRAVINI  
PRIMARY EXAMINER